

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Beachy et al.

Serial No: 09/943,641

Filed: August 30, 2001

For: IDENTIFICATION OF ACTIVATED
RECEPTORS AND ION
CHANNELS

Attorney Docket No. JHUC-P01-017

Art Unit: 1632

Examiner: Priebe, Scott D.

TECH CENTER 1600/2900

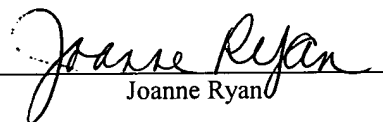
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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner for Patents Washington, D.C. 20231 on the date indicated below:

December 9, 2002

Date of Signature
and of Mail Deposit


Joanne Ryan

Commissioner of Patents
Washington, D.C. 20231

REPLY TO RESTRICTION REQUIREMENT

Sir:

In reply to the outstanding Restriction Requirement, mailed October 17, 2002, in connection with the above application, Applicants hereby elect Group I (claims 1-32), with traverse.

Applicants elect this claimed invention with traverse, because the subject matter of this Group is closely related to other Groups. Particularly, Group II, V and VI claims depend on claim 1 of Group I. Group III claims are directed to methods of identifying modulators of a mutated receptor / ion channel, and Group IV claims are directed to a transgenic non-human animal expressing a mutated receptor / ion channel. The mutated receptor / ion channel is a very similar subject matter as that of the Group. Therefore, a search of the Group I subject matter will necessarily search the subject matter of Groups II – VI, at least that of Groups II and III. Thus, it would not constitute a significant additional burden to simultaneously examine claims directed to all Groups, especially Groups I – III claims.

Pursuant to MPEP 803, "[t]here are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent ... or distinct as claimed ...; and (B) There must be a serious burden on the examiner if restriction is required ... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant." As demonstrated herein, the election requirement of the Office Action does not satisfy either of the above requirements.

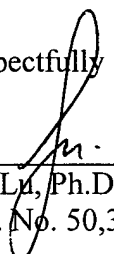
"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (emphasis added, MPEP803).

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition therefor and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Date: December 9, 2002

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Respectfully Submitted,



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